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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,868	07/17/2000	Thomas J. Shaw	75329 77432	8293

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EXAMINER

HAN, MARK K

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/617,868

Applicant(s)

SHAW, THOMAS J.

Examiner

Mark K. Han

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-34, 36-42, 44-50, 52, 54-94 and 96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 58-94 is/are allowed.
- 6) ☒ Claim(s) 29-34, 36-42, 44-50, 52, 54-57 and 96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a rigid plunger seal element stop surface (claim 54) and a third opening (claims 61 and 62).

### ***Claim Objections***

2. Claims 29, 37, 39, 45-50, 58, 67-69, 81 are objected to because of the following informalities:

Claim 29 recites the limitation “the retractable needle retraction mechanism” in line 14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 37 recites “a retractable needle” in the preamble (line 1) of the claim. The claim later recites a limitation of “a needle” in line 4 of the claim. In line 5 of the claim, the claim refers to “the retractable needle”. It appears that the claim is referring to two different needles. Applicant must choose a term and use it consistently.

Claim 37, line 14 refers to “the needle”.

Claim 39, line 2 refers to “the retractable needle”. Claim 39, line 3 has two instances of “the needle”.

Claim 45 recites “a retractable needle” in the preamble (line 1) of the claim. The claim later recites a limitation of “a needle” in line 4 of the claim. It appears that the claim is referring to two different needles. Applicant must choose a term and use it consistently.

Claim 45 recites the limitation “the continuous retaining member” in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 45 recites the limitation “the retractable needle retraction mechanism” in line 13 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 46 recites the limitation “the continuous retaining member” in lines 1-2 and 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 47, line 2 refer to “the retractable needle”.

Claim 47, line 3 refer to “the needle” (two instances).

Claim 48 recites the limitation “the continuous retaining member” in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 48, line 2 refers to “the retractable needle”.

Claim 49 recites the limitation “the continuous retaining member” in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 49, line 2 refers to “the retractable needle”.

Claim 50 recites the limitation “the continuous retaining member” in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 50, line 2 refers to “the retractable needle”.

Claim 58 recites the limitation “the first opening” in lines 7 and 28 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 58 recites the limitation “the second opening” in lines 7-8 of the claim. There is insufficient antecedent basis for this limitation in the claim.

In claim 58, line 19, “and” should be deleted.

Claims 61 and 62 recite the limitation of "third opening" in line 2 of each claim. There are no first and second openings, but there are first and second open ends. Applicant must be consistent in the use of claim terminology through out the claim and its dependents.

Claim 67 recite the limitation of "fourth opening" in line 2 of each claim. There is no first, second or third opening. Applicant refers to a fourth opening without the recitation of a third. It is unclear whether a third opening should be implied.

Claim 69 recites the limitation "the second opening" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

In claim 81, line 16 of the claim, "and" should be deleted.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-34, 36-42, 44-50, 52, 54-57 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,019,044 to Tsao (as cited by Applicant) in view of U.S. Patent No. 5,304,138 to Mercado (as cited by Applicant).

Tsao discloses a syringe having a hollow syringe body 12, retractable needle 30, continuous retaining member 26, plunger 50, plunger seal 60, a structure in the front end portion 18 and plunger tip 51. See Figures 1-4. Tsao, however, does not disclose that the outer

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periphery of the plunger end cap to be receivable into the opening of the back end of the syringe body upon retraction. Mercado discloses a syringe having a plunger 22 having an outer periphery 24 such that upon completion of the delivery stroke, the outer periphery sits within the body of the syringe. This discourages anyone from reusing the syringe. See Figure 1. See also col. 1, lines 40-54 and col. 2, lines 25-39. It would have been obvious to one of ordinary skill in the art to modify the invention of Tsao, by having the outer periphery of the plunger to sit within the body of the syringe, as suggested by Mercado, in order to prevent reuse of the syringe and the spread of disease from the use of contaminated syringe.

#### ***Allowable Subject Matter***

4. Claims 58-94 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter:

The subject matter of the independent claims could either not be found or was not suggested in the prior art of record. The subject matter not found was the needle retraction mechanism that is grounded inside the nose having an elongate needle holder where the needle holder has a needle holding portion extending forwardly through the first open end (claims 58 and 81) in combination with the other elements (or steps) in the claims.

#### ***Response to Arguments***

6. Applicant's arguments, see Remarks, p. 22, line 9 through p. 23, line 5, filed 13 March 2006, with respect to claims 29-34, 37-42, 44-50, 52, 54-57, 81-85, 88-94 and 96 have been fully considered and are persuasive. The rejection under 35 U.S.C. §102(a) of those claims has been

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withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tsao in view of Mercado.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark K. Han whose telephone number is 571-272-4958. The examiner can normally be reached on Monday to Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER



Mark K. Han  
Patent Examiner  
Art Unit 3767

mkh  
June 24, 2006